



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,596	08/19/2003	Choo Yuen May	3587-0110P	2776
2292 7590 03/26/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER CLARK, AMY LYNN	
			ART UNIT	PAPER NUMBER
			1655	
SHORTENED STATUTORY PERIOD OF RESPONSE		NOTIFICATION DATE		DELIVERY MODE
31 DAYS		03/26/2007		ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 31 DAYS from 03/26/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 10/642,596	Applicant(s) MAY ET AL.	
	Examiner Amy L. Clark	Art Unit 1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,8,9,11,12 and 14-22 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1,8,9,12 and 14-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's election with traverse of Group I in the reply filed on 5 January 2007 is acknowledged.

The traversal is on the ground(s) that according to MPEP § 803, if the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. Applicant further argues as evidence of the undue burden, the Examiner has listed that class 514/subclass 1 is to be searched for Group II and class 424/subclass 727 is to be searched for Group I and in view of the fact that the computer searching software used by the Examiner enables the Examiner to combine the search for patents in multiple subclasses without having to view duplicates, the search of one extra subclass would not amount to an undue burden on the Examiner to consider all of claims 1, 8, 9, 11 and 14-22 and as such, Applicants respectfully request that the Examiner rejoins Group II with Group I.

However, this is not persuasive because in response to Applicant's argument that according to MPEP § 803, if the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions, that as evidence of the undue burden, the Examiner has listed that class 514/subclass 1 is to be searched for Group II and class 424/subclass 727 is to be searched for Group I and in view of the fact that the computer searching software used by the Examiner enables the Examiner to combine the search for patents in multiple subclasses without having to view

duplicates, the search of one extra subclass would not amount to an undue burden on the Examiner to consider all of claims 1, 8, 9, 11 and 14-22 and as such, please note the following. Vitamin E, squalene or phytosterols may be extracted using different steps, from different starting material and using a different solvent system. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper. Furthermore, in response to Applicant's argument that the computer searching software used by the Examiner enables the Examiner to combine the search for patents in multiple subclasses without having to view duplicates, the search of one extra subclass would not amount to an undue burden on the Examiner to consider all of claims 1, 8, 9, 11 and 14-22 and as such, please note that a classification search is a rough search that provides thousands of possibilities and Applicant should note that a search for Vitamin E will not necessarily provide the method of extraction claimed by Applicant (the Examiner specifically directs Applicant to class 514, subclass 1 and class 424, subclass 727. Please note in the case of class 514, subclass 1, that this class and subclass contains any type of organic active ingredient, which is not simply limited to Vitamin E, therefore, a search based strictly on a class and subclass search is inefficient. Applicant's attention is also drawn to class 424, subclass 727, wherein the subclassification is drawn to the family, "Palmaceae", which contains several genres and species related to date, coconut, saw palmetto, etc. Again, this classification

Art Unit: 1655

search is generic and again, a search within in the subclass is inefficient. Therefore, simply performing a classification search provides numerous hits that may not provide the information that the Examiner is specifically searching for, and therefore, is an ineffective and burdensome way to search.

Therefore, the requirement is still deemed proper and is therefore made **FINAL**.

Claims 1, 8, 9, 11, 12 and 14-22 are currently pending.

Claim 11 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 5 January 2007.

Please note that claim 12 has been amended to read on claim 1 and is now part of Group I. Based upon the fact that Applicant has now amended claim 12 to read on the elected Group, a new requirement for an election of species is now required.

Claims 1, 8, 9, 12 and 14-22 are currently under examination and subject to a species election.

Election/Restrictions

This application contains claims directed to the following patentably distinct species:

Group I:

Specie A: Elect the method of claim 1 and the method of claim 12.

Or

Specie B: Elect the method of claim 1 and further elect from each of the following method steps:

- i.) elect the step recited either in claim 8 or claim 21.
- ii.) elect the step recited either in claim 14 or claim 15.
- iii.) elect the step recited either in claim 17 or claim 18.

Please note that in electing Specie A, only claims 1 and 12 will be examined. In electing Specie B all further elected claims elected will be examined, however, claim 12 will **not** be examined.

The species are independent or distinct because the methods require different steps and different search criteria. Therefore, a search for one method is not co-extensive with a search for all other methods and a search for all possible method steps would be burdensome.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 16, 20 and 21 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy L. Clark whose telephone number is (571) 272-1310. The examiner can normally be reached on 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Amy L. Clark

Application/Control Number: 10/642,596

Page 7

Art Unit: 1655

AU 1655

Amy L. Clark
March 14, 2007


MICHELE FLOOD
PRIMARY EXAMINER